

REMARKS/ARGUMENTS

INTRODUCTORY COMMENTS:

In a previous Office Action, the Examiner issued a number of formality-based claim rejections and a number of art-based rejections over U.S. Patent Nos. 6,342,349 to Virtanen, 6,395,562 to Hammock et al. ("Hammock"), and 6,284,459 to Nova et al. ("Nova"). In response, applicants made a number of amendments to the claims and introduced a number of new claims. As a result, claims 1-9, 11-50, and 91-106 were pending.

In the Office Action under reply, the Examiner withdrew the formality-based claim rejections. However, the Examiner issued a new restriction requirement between device and method claims, deemed the device claims constructively elected, and withdrew claims 45-50, 92 and 104-106 from consideration. In addition, the Examiner reiterated her previous grounds for rejection. Accordingly, all claims under consideration stand rejected as follows:

(1) Claims 1, 5-9, 11-17, 21, 22, 30-32, 37-43, 91, and 96-103 stand rejected under 35 U.S.C. §102(e) as anticipated by Virtanen;

(2) Claims 2-4 and 33-36 stand rejected under 35 U.S.C. §103(a) as obvious over Virtanen in view of Hammock; and

(3) Claims 1, 2-9, 11-13, 18-27, 31, 32, 37, 39, 40, 42-44, 91, and 93-95 stand rejected under 35 U.S.C. §103(a) as obvious over Nova in view of Virtanen.

The rejections are addressed in part by the above amendments to the claims and are otherwise traversed for reasons that will be discussed in detail below.

THE ABOVE AMENDMENTS:

Independent claim 1 has been amended to indicate that the invention relates to a device for *performing an experiment with a target moiety* that is comprised of a substrate having a plurality of *probe* moieties each attached to a designated site on a surface thereof and containing machine-readable information relating to the *probe and/or target* moieties. In addition, the claim sets forth that an *interaction between the target moiety and a probe moiety results in a detectable response signal*. The information is represented by a *data signal that has the same detectable/readable form as the response signal*. As indicated in new claim 107, the signals may be in a *radioactively detectable form*. Correspondingly, new claims 108 and 109 set forth a machine and a method for performing an experiment involving the device of claim 1.

These amended and new claims are supported throughout the specification, e.g., on page 35, line 23, to page 36, line 18, and by claims 47, 49, and 60 as originally filed. Accordingly no new matter has been introduced by way of these new and amended claims.

Dependent claims 5-8 13-17, 21, 22, 24, 25, 29, 30, 33-36, 41, 44, 91, 94, and 96 have been amended to render the terminology contained therein consistent with that of the claims from which they depend. As such, no matter has been introduced in any of these formality-based claim amendments.

To expedite prosecution, restricted-out claims 45-50, 92, and 104-106 are canceled without prejudice.

Thus, no matter has been introduced by way of any of these amendments and entry thereof is proper and requested.

STATUS OF THE CLAIMS:

Claims 1-9, 11-44, 91, 93-103, and 107-109 are pending. Claims 1, 5-8, 13-17, 21, 22, 24, 25, 29, 30, 33-36, 41, 44, 91, 94, and 96 are currently amended. Claims 10, 45-90, 92, and 104-106 are canceled. Claims 107-109 are newly added. Claims 2-4, 9, 11, 12, 18-20, 23, 26-28, 31, 32, 37-40, 42, 43, 93, 95, and 97-103 remain unchanged.

THE OUTSTANDING REJECTIONS:

All claims stand rejected over art listed above. In reply to applicants' amendments and arguments, the Examiner reiterated her previous position. In addition, the Examiner stated that the process steps, as introduced by amendment in applicants' previous response, do not distinguish the claimed devices over a device made by another method.

With the above amendments, the claims no longer recite the process steps used to make the inventive device.

In addition, the outstanding rejections are rendered moot by the new and amended claims. All pending claims relate to a device for performing an experiment with a target moiety. The device is comprised of a substrate having a plurality of probe moieties each attached to a designated site on a surface thereof and containing machine-readable information relating to the probe and/or target moieties. Unlike technologies described in the cited references, an interaction between the target moiety and a probe moiety results in *a detectable response signal*


that has the same detectable/readable form as the data signal representing the machine-readable information. As a result, the same means may be advantageously used both to (1) detect for a response signal resulting from an interaction between the target and probe moieties and (2) read the machine-readable information. The cited art neither discloses nor suggests the subject matter of the pending claims.

CONCLUSION

Accordingly, it is submitted that the pending claims define an invention that is patentable over the art. As the application should now be in condition for allowance, a prompt indication to that effect would be appreciated.

If the Examiner has any questions concerning this communication, she is welcome to contact the undersigned attorney at (650) 330-0900.

Respectfully submitted,

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